

Application No. 10/666,453
Amendment dated May 10, 2005
Reply to Office Action of February 10, 2005

REMARKS

Claims 19-30 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of US 6,379,832. Claims 19-24 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being patentable over claims 19-21 of co-pending Application No. 10/792,987. Lastly, claims 19, 20, 23-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by US 4,628,298 to Hafle et al. [Hafle]. The Applicants verified with a telephone call to Examiner Allen on May 10, 2005 that US 6,379,832 cited in the double-patenting rejection should be US 6,376,832.

The Applicants have amended independent claims 19 and 26 and added new independent claims 31 and 32. After entry of the present amendment, claims 19-32 are pending. Also included with this amendment are two (2) terminal disclaimers.

I. Double Patenting Rejections

A. US 6,379,832

The Office Action first rejected claims 19-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of US 6,379,832. As noted above, the Examiner confirmed that US 6,379,832 was incorrectly cited. The reference of this rejection should be US 6,376,832. The Applicants have included a terminal disclaimer to US 6,376,832.

B. US 10/792,987

The Office Action also provisionally rejected claims 19-24 under the judicially created doctrine of obviousness-type double patenting as being

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patentable over claims 19-21 of co-pending Application No. 10/792,987. The '987 application is now US 6,878,927. Applicants have included with this response a terminal disclaimer to the '927 patent.

II. Section 102 Rejections

The Office Action also rejected claims 19, 20, 23-30 under 35 U.S.C. § 102(b) as being anticipated by Hafle. The Applicants have amended independent claims 19 and 26 to require "two or more rotary members" instead of one or more rotary members. Support for this amendment can be found in the Applicants' specification and particularly on page 9, line 27 through page 10, line 12 and in Figure 6.

Amended claims 19 and 26, which now require two or more rotary members, are not anticipated by Hafle because Hafle only discloses a single rotary member. For example, Hafle illustrates a single code disk 12 in FIGS. 1B, 2, and 3 and a single rotating member or scan wheel 102 in FIGS. 5 and 7. Moreover, it would not be obvious for one skilled in the art to modify Hafle to arrive at the claimed invention because the reference discloses "[a] positional encoder which provides absolute position information from a single code track." (Abstract) A single code track can not be incorporated into two or more rotary members as required by amended claims 19 and 26.

As a result, the Applicants respectfully request the withdrawal of the rejection to claims 19, 20, and 23-30.

III. New Claims 31 and 32

Applicants have also added new claims 31 and 32. Claim 31 is a new independent claim that includes all the limitations of the prior claim 19 and

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dependent claim 21. Claim 32 is a new independent claim that includes all the limitations of the prior claim 19 and dependent claim 22.

In the Office Action, dependent claims 21 and 22 were only rejected under the judicially created doctrine of obviousness-type double patenting over either US 6,372,832 (or 6,376,832 as discussed above in Section I) or Application No. 10/792,987 (now US 6,878,927). As previously stated, Applicants have included a terminal disclaimer to US 6,376,832 and a terminal disclaimer to US 6,878,927 along with this response and amendment.

Accordingly, the Applicants respectfully request new independent claims 31 and 32 be allowed.

IV. Conclusion

Applicants respectfully request that the Examiner allow pending claims 19-32 and pass this application to issue. If the Examiner believes that a telephonic or personal interview would be helpful to terminate any issues which may remain in the prosecution of the application, the Examiner is requested to telephone Applicants' attorney at the telephone number set forth hereinbelow.

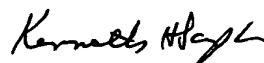
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The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication or credit any overpayment to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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